REMARKS

Initially, Applicants wish to thank Examiner Senfi for return of the PTO-1449 Form attached to the Response under 37 C.F.R. § 1.111 filed on April 1, 2004 confirming consideration of the information cited in the Information Disclosure Statement filed on April 2, 2001.

Applicants further wish to thank the Examiner for his indication that the claims in the present application are clearly patentable over the references cited in the last Official Action, as indicated by his withdrawal of the previous rejection.

In the outstanding Official Action, the Examiner rejected claims 1-5 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,717,609. The Examiner admitted that the claims are not identical but asserted that they are not patentably distinct from each other.

In particular, the Examiner asserted that the claims of the present application (claims 1 and 5 of the present application) are broader than patented claim 6 of U.S. Patent No. 6,717,609. Accordingly, the Examiner concluded that allowing claims 1-5 of the instant application would unduly extend the timewise monopoly of the patent. The Examiner requested that Applicants submit a Terminal Disclaimer.

Applicants respectfully traverse the Examiner's rejection and submit that it is inappropriate on numerous grounds. Accordingly, Applicants submit that the filing of a

Terminal Disclaimer is not necessary and accordingly they have not filed one at this time. On the contrary, Applicants submit that each of the claims pending in the present application is clearly patentable and an action to such effect is respectfully requested in due course.

Initially, Applicants note that the Examiner has rejected all of claims 1-5 under the judicially created doctrine of obviousness type double patenting. However, on its face, this rejection is clearly inappropriate. In particular, at least with respect to the recitations of claims 2-4, these features (or obvious modifications thereof) are clearly not recited in claim 6 of U.S. Patent No. 6,717,609. In particular, claim 6 does not recite for example "adjusting the color tone by adjusting gains and gamma factors of the video signals", that the "video signals comprise red, green and blue component video signals", or that the "video signal processor starts to process video signals fed from an electronic endoscope unit....when a selected electronic endoscope unit is switched to the newly selected electronic endoscope unit" as recited in these claims. Accordingly, for these reasons alone, it is respectfully submitted that the rejection is inappropriate with respect to claims 2-4.

Additionally, the Examiner's assertion that present claims 1-5, because they are broader than patented claim 6 would serve to unduly extend the timewise monopoly of the patent is also submitted to be incorrect on its face. In particular, Applicants note that the present application was filed on January 3, 2001. On the other hand, U.S. Patent No. 6,717,609 was filed on January 9, 2001. Accordingly, the patent to issue from the patent

application will expire several days before the above-noted patent. Thus, there is no timewise extension of the monopoly involved in allowing the claims in the present application.

Moreover, even if the claims in the present application are broader than those of patented claim 6 of the patent, that in and of itself is an insufficient and inadequate reason for rejecting the claims of the present application under the judicially created doctrine of obviousness type double patenting. In particular and as noted previously, the present application was filed before the application that matured into U.S. Patent No. 6,717,609 and since the present application contained the broader claims (according to the Examiner), the present application should have been issued before U.S. Patent No. 6,717,609. That the present application with the broader claims did not issue before the narrower claims is not an adequate or sufficient reason to require Applicants to submit a Terminal Disclaimer.

Applicants further submit that the Examiner, in a situation such as the present (where the application was filed before the filing date of the patent), must provide evidence of two-way obviousness. However, the Examiner has not done so. The Examiner's attention is respectfully directed to *In re Braat*, 937 Fed. 2nd. 589, 19USPQ 2nd. 1289 (Fed. Cir. 1991). The Examiner's attention is also respectfully directed to the MPEP at § 804.

Yet additionally, the Examiner has made no compelling evidentiary based case of obviousness with respect to the claims of the present application over the claims of U.S. Patent No. 6,717,609. Such an evidentiary basis is required for every judicially created doctrine of obviousness type double patenting rejection. Merely because the Examiner asserted that the present claims are broader, even if true, is an inadequate basis for the judicially created obviousness type double patenting rejection asserted against the claims in the present application.

Moreover, Applicants respectfully submit that contrary to the Examiner's assertion, the claims of the present application are not broader than the claims of U.S. Patent No. 6,717,609. In particular, utilizing claim 1 as an example, the present invention, generally speaking, comprises a video signal switching processor, a video signal processor, an image state parameter storing processor and an image state parameter setting processor.

The claims of U.S. Patent No. 6,717,609 do not recite all of these four features. While the Examiner might assert that claims 2 and 4 recite structure generally corresponding to the video signal switching processor and the video signal processor, and that claims 5 and 6 can be considered to correspond to the image state parameter storing processor, it is respectfully submitted that none of the claims of the asserted patent contain a recitation corresponding to the image state parameter setting processor. Accordingly, at least for this reason, it is

respectfully submitted that claims 1 and 5 of the present application are not broader than claim 6 of the patent.

For each of these reasons and certainly for all of these reasons, it is respectfully submitted that claims 1-5 of the present application are not properly rejectable under the judicially created doctrine of obviousness type double patenting over claim 6 of U.S. Patent No. 6,717,609. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claims 1-5 and an indication of the allowability thereof in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

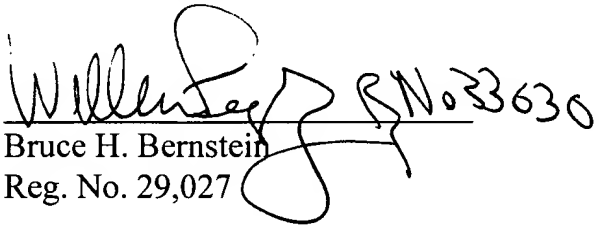
SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have traversed the Examiner's rejection and have shown the same to be inappropriate. Applicants have provided numerous evidentiary bases supporting the patentability of the claims in the present application as well as supporting the conclusion that the Examiner's obviousness type double patenting rejection is inappropriate.

Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully request an indication to such effect in due course.

Should there by any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Hideo SUGIMOTO et al.



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